



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Thomas R. Goecke**

Confirmation No.: **2438**

Serial No.: **10/674,108**

Art Unit: **1772**

Filed: **September 29, 2003**

Examiner: **Nasser Ahmad**

Title: **PRESSURE SENSITIVE ADHESIVE TAPE
FOR FLOOR MARKING**

Appeal No.: **2008-4501**

Docket No. **5923.0001**

MAIL STOP: APPEAL BRIEF – PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

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Denise Goldinger

Items enclosed herewith

1. Transmittal Form (1 page)
2. Brief (7 pages)
3. Return receipt postcard



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Dear Sir:

REQUEST FOR REHEARING UNDER 37 CFR §41.52

This Request for Rehearing ("Request") is being filed in response to the Decision on Appeal dated February 19, 2009 ("Decision"). As the Request is being filed within two (2) months of the Decision and is timely.

In the Decision, the Board of Patent Appeals and Interferences ("the Board") affirmed the rejections of claims 1-7 and 9-12 as being unpatentably obvious over various combinations of three references. The Applicant respectfully requests reconsideration of the Decision for the reasons set forth below.

The rejections upheld by the Decision are all obviousness-type rejections variously combining an elastic electrical tape ("Oace"), an inelastic wallboard spacer ("Hughart") and an inelastic polymer backing used in a tape ("Guenther"). The Board

has overlooked or misapprehended several points raised in the briefs as discussed particularly below.

The Office Fails to Make Prima Facie Case of Obviousness

Relevant case law requires that a proper obviousness rejection under 35 U.S.C. § 103 identify each and every claim limitation in the prior art (KSR International Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974)). The KSR Court noted that merely finding each claimed element in the prior art, without more, was insufficient to find the invention obvious. Id. Here however, the Office has not provided substantial evidence identifying each and every claimed element in the prior art. A reviewing court must reverse the Board's findings if they are unsupported by substantial evidence. Dickinson v. Zurko, 527 U.S. 150, 152 (1999); 5 U.S.C. § 706 (2007).

Claim 11

Independent Claim 11 calls for, among others, an adhesive tape comprising an average thickness between 65 mil and 69 mil. See, Claim 11; Appeal Brief, p. 12 (inadvertently referencing units of “millimeter” instead of “mil,” as claimed).

Certain conversion principles may be helpful to have in the record. A “mil” is a unit identifying 1/1000th of an inch. A micro-meter or micron (designated μm) is 10^{-6} meter. A meter is 39.37 inches. A micro-meter is thus 0.00003937 inches. These conversions are capable of such instant and unquestionable demonstration as to defy dispute. MPEP 2144.03 (A). The chart below converts units in the claim and the applied references to inches.

Claim 11 (polymer and adhesive)	Oace (backing film)	Hughart (spacer)	Guenther (polymer and adhesive)
65 – 69 mil	4 – 20 mil	.5 inch (estimate)	70 – 600 μ m
.065 – .069 inch	.004 – .02 inch	.5 inch	.0028 – .024 inch

From the conversions outlined above, it is plain that none of the references disclose or suggest a tape with a polymer plus adhesive thickness in the .065 – .069 inch claimed range. Indeed, the closest endpoint in the Guenther range would need to be increased by almost 300% to meet the claim.

Neither the Examiner nor the Board has made any attempt to address the failure. In the Examiner's answer, claim 11 receives a scant five sentences of discussion (Examiner's Answer, pp. 6 and 8) none of which even mention the thickness limitation. The Decision only refers to the various thickness limitations in passing (Decision, p. 8) and does not find that the prior art included each element claimed – as is required to support a prima facie case of obviousness.

Because the Examiner failed to meet the initial burden of supporting a prima facie case of obviousness, the rejection is not supported by substantial evidence and should be reversed.

Claims 1 and 12

Independent Claims 1 and 12, among others, each recite a thickness range of between 0.020" to 0.065". Claim 1 calls for the range of thicknesses to be "about" 0.020" to 0.065", while claim 12 recites the range of 0.020" to 0.065".

The Examiner and the Board conclude that Oace's tape includes a polymer with a backing film of 4 to 20 mils thickness. (Answer, p. 3; Decision, p. 3.) While not expressly stated, the rejections appear to be that Oace's disclosure of a range of 4 - 20 mils, equal to 0.004 - 0.020 inches, anticipates the claimed range 0.020 – 0.065 inches by

touching the lower boundary, i.e. 0.020 inches. This position, that Oace is deemed to anticipate the claimed thickness range is evidenced by the Examiner's combination of the Hughart reference in claim 1 (to teach only the hardness) and the Guenther reference in claim 12 (to teach only the peel adhesion). In other words, since neither secondary reference addressed the thickness limitation, it would have to be taught by the primary reference, Oace, to properly form the basis of rejection.

The Court of Appeals for the Federal Circuit has held that it is reversible "clear error" for a court to conclude that a partially overlapping range anticipates a different claimed range. Atofina v. Great Lakes Chem. Corp., 441 F.3d 991, 78 USPQ2d 1417 (Fed. Cir. 2006). In Atofina, the lower court found that a prior art reference disclosing a temperature range of 150 – 350 °C rendered a claimed range of 330 – 450 °C unpatentable. The Federal Circuit reversed reasoning that the slight 20 °C overlap is not disclosed as a species of the claimed generic range. "The [prior art] disclosure is only that of a range, not a specific temperature in that range, and the disclosure of a range is no more a disclosure of the end points of the range than it is of each of the intermediate points." Id.

Here, the Office erroneously contends that an overlap at only one point – 0.020 inches – is sufficient disclosure of the claimed range. This is clear error. Quoting the Atofina court, "although there is a slight overlap, no reasonable fact finder could determine that this overlap describes the entire claimed range with sufficient specificity to anticipate this limitation." Id. Because the Examiner failed to meet the initial burden of supporting a prima facie case of obviousness, the rejection is not supported by substantial evidence and should be reversed.

Even If The Unexplained Failures Of The Prior Art Are Overcome, The Proposed Combinations Cannot Support an Obviousness Rejection.

An obviousness rejection is improper if the proposed modification would render the prior art unsatisfactory for its intended purpose. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). All the combinations suggested by the Examiner would defeat the purpose of one or both references. See, Appeal Brief, pp. 7 - 8.

Claims 1-7 and 9-11

Claims 1-7 and 9-11 stand rejected as obvious combinations of the elastic, electrical tape described by Oace and the inelastic spacer strips described by Hughart. (Examiner's Answer, pp. 3-4 and 6). The Office concedes that Oace fails to teach the hardness limitations, but points to Hughart to remedy the deficiency. In support of combination, the Examiner declared it would be obvious to modify Oace "to provide for hardness imparted for structural strength to the tape." Id.

However, modifying the Oace tape "to provide for hardness imparted for structural strength" would render it unsatisfactory for its intended purpose. Oace describes, and the Decision acknowledges, that one intended feature of Oace is to provide "a stretchable and elastic" tape. (Oace, col. 3, lines 56-75; Decision, p. 3). The intended purpose of stretchability and elasticity are typically associated with "softer" items. See, Oace, col. 6, lines 74-75 and col. 1, line 48 bridging to col. 2, line 1. Despite the express purpose, the Office proposes "hardening" the tape to the upper limits of the Shore A hardness scale overlooking the adverse effects to the important stretch and elastic characteristics.

Because the proposed combination would render the prior art unsatisfactory for its intended purpose by making the Oace tape inelastic, the rejection is improper and should be reversed.

Claim 12

Claim 12 stands rejected as an obvious combination of the elastic, electrical tape described by Oace and the diaper tape of Guenther. (Examiner's Answer, p. 5). Oace admittedly fails to teach the peel adhesion limitation, and the Office looks to Guenther to provide the teaching. The Office reasons that the motivation for the combination is "to provide for improved peel adhesion." Id.

Oace's electrical tape is intended to be wound upon itself in roll form on suitable cores. (Oace, col. 5, lines 48-50; col. 8, lines 59-60; and col. 9, lines 21-22). In use, the tape is pulled off the rolls by hand and stretched onto a workpiece such as a wire splice. (Oace, col. 4, lines 32-44; col. 7, lines 15-17). The adhesive is repeatedly described as "tacky," but "eucohesive" meaning that the adhesive will not delaminate when unwound and handled. (Oace, col. 3, lines 6-12; and col. 9, lines 3-7).

Guenther describes a completely different adhesive that would destroy the features expressly described and claimed by Oace. Guenther describes its adhesive (12) as "permanently" attaching the tape to the diaper. (Guenther, col. 8, lines 3-8). It is the discussion of this permanent adhesive that the Office relied upon as disclosing the claimed peel adhesion limitations. (Examiner's Answer, p. 5). To be sure, a permanent adhesive on Oace's electrical tape would render it inoperable as a user would be unable to unroll the tape to apply to a workpiece. The Board attempts to remedy the failure of the proposed combination by citing to an alternative embodiment of a removable

adhesive rendered “partially detackified.” (Decision, p. 4). What is missing from the alternative “partially detackified” embodiment however, is the peel adhesion claim limitation. In other words, the claim and Guenther’s permanently adhered embodiment are not intended to be easily removed. Thus, a relatively “strong” peel adhesion is described. Oace and Guenther’s alternate embodiment are intended to be user peelable, thus, have a relatively “weak” peel adhesion. To the extent Guenther discloses a strong peel adhesion, it destroys the obviousness rejection by rendering the primary Oace reference unsuitable for its intended use. To the extent Guenther discloses a weak peel adhesion, it destroys the obviousness rejection by not teaching each and every element.

In view of the foregoing, the Applicant respectfully submits that the rejections are without substantial evidence, are all overcome or both. The Decision should be reconsidered and the Examiner reversed.

CONCLUSION

All pending Claims 1-7 and 9-12, have not been shown to be obvious. Applicant requests that all rejections be reversed and that all claims be allowed.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Although it is believed that no fees are necessary, the director is hereby authorized to charge payment of any fees associated with this communication or credit any over payment to Deposit Account No. 504883.

Respectfully submitted,



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Date: April 17, 2009

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